

### **REMARKS**

Upon entry of the foregoing Amendment, claims 1-76 are pending. Claims 30, 59, 64, and 69 have been amended solely to correct typographical errors and have not been amended to overcome rejections based on prior art. No claims are cancelled and no claims are added. No new matter is added.

In view of the following Remarks, allowance of the pending claims is requested.

#### **Examiner Interview**

Applicant thanks Examiner Tabatabai for the courtesies extended to Inventor, Soheil Shams, and Applicants' representative Timothy Rooney during the telephone Interview of December 19, 2005 (Telephone Interview). During the Telephone Interview, Mr. Shams, Applicant's representative, and the Examiner discussed distinctions between the claims and the references relied upon by the Examiner. The Examiner indicated that in at least one instance, the Non-Final Office Action mailed August 22, 2005 (Non-Final Office Action) included an errant citation to a portion of U.S. Patent No. 6,057,101 to Nandabalan et al. (Nandabalan) that allegedly discloses a particular feature of the claimed invention. The Examiner indicated a different portion of Nandabalan as the intended citation during the interview. Mr. Shams and Applicant's representative proceeded to point out distinctions between the intended citation and the claimed invention.

As set forth below, Applicant maintains that the rejected claims are patentable over the references relied upon by the Examiner. Accordingly, allowance of the pending claims is requested.

#### **Double Patenting Rejection**

The Examiner has rejected claim 76 under the judicially created obviousness-type double patenting rejection in view of U.S. Patent No. 6,731,781 (the '781 Patent). Applicants traverse this rejection because claim 76 includes patentably distinct features from claim 1 of the '781 Patent. Applicant expressly reserves the right to demonstrate

the patentable differences should the need arise. Nevertheless, solely to expedite prosecution, Applicant will submit a terminal disclaimer upon indication of the allowance of the claims to obviate this rejection.

**Rejections Under 35 U.S.C. §102**

The Examiner has rejected claims 1-3, 17-21, 35-39, and 53-72 as allegedly anticipated under 35 U.S.C. §102(b) by Nandabalan. Applicant traverses these rejections because Nandabalan does not disclose all the features of the claimed invention.

For example, independent claim 1 recites: "*a processor for...determining therefrom a level of confidence in the signal characterizing output of the process.*" In the Non-Final Office Action at pg. 3, the Examiner cites Nandabalan, col. 31, ll. 38-42 as allegedly disclosing this feature of the invention. As mentioned above, during the Telephone Interview, the Examiner indicated that this citation was in error, and that another citation in Nandabalan (portions of col. 29) was intended to be included in the Non-Final Office Action. Neither the citation in the Non-Final Office Action nor the intended citation discussed during the Telephone Interview disclose a processor for determining a level of confidence in a signal characterizing output of a process of assessing chemical materials. At best, these portions of Nandabalan disclose a "confidence level that [a protein-protein] interaction will be retrieved..." This is not a level of confidence in a signal characterizing output of a process of assessing chemical materials.

For at least these reasons, the Examiner has not shown that Nandabalan discloses each and every feature of independent claim 1. As such, the Examiner's rejection of claim 1 must be withdrawn. Independent claims 19 and 37 include similar features to claim 1. Accordingly, the Examiner has not shown that Nandabalan discloses each and every feature of claims 19 and 37, and the Examiner's rejection thereto must be withdrawn.

Claims 2-3, 17-18, 20-21, 35-36, 38-39, and 53-72 each depend from and add features to one of independent claims 1, 19 or 37. Accordingly, these dependent claims are also patentable over the reference relied upon by the Examiner and the rejections thereto must be withdrawn.

**Rejections Under 35 U.S.C. §103**

The Examiner has rejected claims 4-16, 22-34, 40-52, and 73-75 under 35 U.S.C. §103(a) as allegedly being unpatentable over Nandabalan in view of U.S. Patent No. 5,720,928 to Schwartz (Schwartz). Applicant traverses this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

Three requirements must be met to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a). The requirements are: (1) the prior art must teach or suggest all the claims limitations; (2) there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings; and (3) there must be a reasonable expectation of success. MPEP §2142.

Applicant submits that there exists no teaching, suggestion, or motivation to modify Nandabalan to include the teachings of Schwartz. Assuming *arguendo* that such a motivation does exist, these rejections are still improper because Nandabalan does not teach or suggest all of the features of the independent claims from which the rejected claims depend (see discussion above regarding rejections under 35 U.S.C. §102(b)). As such, the rejection of claims 4-16, 22-34, 40-52, and 73-75 must be withdrawn.

**Information Disclosure Statement**

Applicant hereby makes the Examiner aware of co-pending U.S. Application No. 10/256,101 (the '101 application), which deals with related subject matter. Submitted herewith is an information disclosure statement. Included in the information disclosure statement are three office actions from the Examiner in the '101 application.

**CONCLUSION**

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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Respectfully submitted,

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